

**Remarks** in response to the Office Action dated June 20, 2005 begin on page 3 of this paper.

## **REMARKS**

Claims 13-20 are pending in the application.

Applicants note the Examiner has withdrawn the paragraph 112 rejection.

Reconsideration of the rejections set forth in Office Action is requested based on the following remarks.

### **I. Provisionally Rejected Claims Under Nonstatutory Double Patenting**

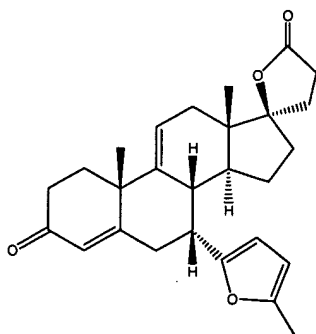
Claims 13-20 are provisionally rejected under the judicially-created doctrine of obviousness-type double patenting based upon claims 16-38 of copending Application No. 10/392,833. The Examiner's provisional rejection for obviousness-type double patenting is noted.

### **II. Claim Rejections under 35 USC §103(a) in View of Barton**

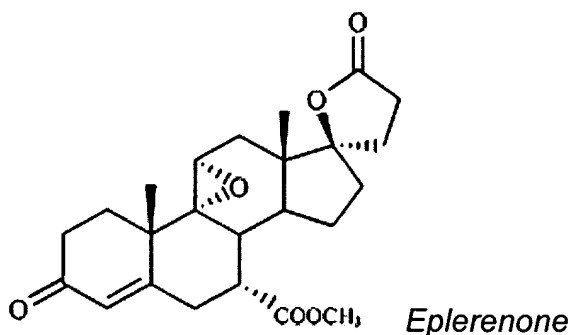
Claims 13-20 are rejected under 35 USC §103(a) as obvious in view of WO 01/41535A2 to Barton, *et al.* (Barton).

In response, Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of obviousness. To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Applicants assert that Barton fails to teach or suggest the compound set forth in independent claim 13.

Independent claim 13 depicts a compound having the following formula:



Barton discloses crystalline forms of the compound entitled Eplerenone, which has the formula represented below.

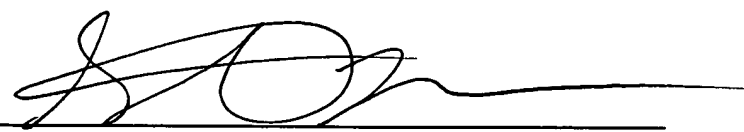


Due to the foregoing, Applicants respectfully assert that independent claim 13 and dependent claims 14-20 are patentably distinct over Barton and are in condition for allowance.

Therefore, Applicants respectfully request the Examiner to reconsider the rejections in the Office Action and allow this Application. The Examiner is invited to telephone the undersigned should any issues remain after the consideration of this response. Please charge any additional fees or credit any overpayments that may be required to Deposit Account No. 19-1025.

Respectfully requested,

September 15, 2005  
Date



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